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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY	DOCKET NO.
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EXAMINER

MEISLIN, D

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

02/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

110145

Applicant(s)

Examiner

Group Art Unit

3723

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

3

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/6/99
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-14 is/are allowed.
- ☒ Claim(s) 15-22 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. **The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.**

2. In the cases mentioned in Section 1.42 and 1.43, proof of the power or authority of the legal representative must be recorded in the Patent and Trademark Office or filed in the application before the grant of a patent. 409.01(b) Proof of Authority of Administrator or Executor (37 CFR 1.44). **The certified copy of the "Amended Letters of Special Administration" has not been received.**

3. Submission of the supplemental reissue declaration pursuant to 37 CFR 1.175(b) (1) must be submitted before this reissue application can be allowed

4. Claims 15-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. V. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot

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be recaptured by the filing of the present reissue application.

The limitation omitted in the reissue is “retaining member being generally bowl-shaped and convex toward said magnet”, and omission thereof is related to subject matter surrendered in the original application. The presence of the “retaining member being generally bowl-shaped and convex toward said magnet” limitation was added to the claims for the purpose of making the claims allowable over a rejection made in the application. The omitted limitation was argued in the original application to make the application claims allowable over a rejection in the application as set forth on page 3 of amendment “B”.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6. Applicant contends that there was never any surrender of "retaining member being generally bowl-shaped and convex toward said magnet" since a divisional application (SN 593,396) was filed presenting claims which omitted said limitation. Applicant cites *In re Clement* 45 USPQ2d 1641 which states the following with emphasis added:

"Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, **but it is not dispositive because other evidence in the prosecution history may indicate the contrary.**"

"Footnote 2. For example, if an applicant amends a broad claim in an effort to distinguish a reference and obtain allowance, but promptly files a continuation application to continue to traverse the prior art rejections, circumstances would suggest that the applicant did not admit that broader claims were not patentable -- assuming that the applicant does not ultimately abandon the continuation application because the examiner refuses to withdraw the rejections."

The examiner agrees with the statement of the law, but respectfully disagrees with applicant as to its applicability to the present facts. Applicant filed a divisional application which was directed to a species different from the parent application. The divisional application is directed to an invention other than that prosecuted in the parent application, and is not a continuation application filed to continue to traverse the prior art rejections. The divisional application includes broad claims directed to the different species. Consequently, the limitation "retaining member being generally bowl-shaped and convex toward said magnet" omitted in the reissue is related to subject matter surrendered in the original application since such limitation was added to the claims for the purpose of making the claims allowable over a rejection made in the application as argued in the original application on page 3 of amendment "B".

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7. In Amendment "A" applicant added the following limitation:

"said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween"


Applicant contends that there was never any surrender of "said retaining member and said inner end surface cooperating to retain said magnet therebetween" since claims incorporating that limitation were already subject to the same rejection and it is "said retaining structure including a discrete retaining member friction fitted in said bore outboard of said magnet" that was being argued on page 5 of Amendment "A". The examiner agrees with applicant and consequently withdraws any rejection based thereon.

8. Applicant alleges that claims 15-22 are materially narrower than any claim in the original application and cites *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984) in support thereof. With respect to pages 7-8 of applicant's response, the point of the arguments do not seem to be relevant since they are all missing the "bowl-shaped and convex" limitation which was clearly germane to the prior art rejection. The question of broader and narrower limitations as discussed in *Ball* has been clarified with more precise language in *Clement*. The examiner prefers to not cloud the issue by discussing whether a claim which omits one limitation and adds another limitation should be construed as being a "broader or narrower claim". The question is, as discussed in *Clement*, whether or not a claim omits a limitation which was added during the prosecution of the patent to obtain an allowable claim, or conversely whether the omitted limitation was not a limitation on which patentability was predicated.

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It is clear from the record that applicant surrendered "retaining member being generally bowl-shaped and convex toward said magnet" since such was added to the claims for the purpose of making the claims allowable over a rejection made in the application.

9. Any inquiry concerning this communication should be directed to Examiner Meislin at (703) 308-3671.



D. S. Meislin
Primary Examiner
Group 3720, Art Unit 3723

February 7, 2000